UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/921,569 | 08/06/2001 | Kenichi Sakuma | 862.C2324 | 7063 |

5514 7590 01/17/2007

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

| EXAMINER | |
|---|---|
| RUHL, DENNIS WILLIAM | |
| ART UNIT | PAPER NUMBER |
| 3629 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 01/17/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/921,569 | SAKUMA ET AL. | |
| | Examiner | Art Unit | |
| | Dennis Ruhl | 3629 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *23 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *61-69* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *61-69* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08). Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/23/06 has been entered.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 63,66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

For claims 63,66, the claims as a whole are considered indefinite. What is the result of the "if" situation being claimed? The rest of the claim is also not clear. Is structure being claimed here or a method step, this is not clear at all. What is being claimed in this claim? It is just not clear as to what is being claimed when the entire claim is considered and read as a whole, it just does not make any sense and reads poorly.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 61-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (6609050) in view of Wong (5432904).

For claims 61,63,66 (as best understood),64,67,69, Li discloses a system and method for administering warranty services and repair services for automobiles. Li discloses a management server that has a *storage unit* in the form of databases 93 and 94 (col. 4 , lines 26-33). The databases store information about customer's vehicles. The *check unit* that is adapted to check whether or not certain equipment is under warranty or not is 41. See column 4, lines 26-28 and column 6, lines 49-51. This determination inherently involves the use of the customer database as claimed. The *estimation unit* that can calculate a repair estimate fee is disclosed in column 8, lines 6-

23 and figure 23. On the basis of a code, such as "002", the standardized hours for this service are retrieved, which is what the repair estimate is based on. Because the estimate for the repair is disclosed as being generated, and because a repair estimate inherently includes the cost of any parts needed to do the repair, it is inherent that there is a *determination* unit that determines the "price of the equipment" by looking it up in a database as claimed (in a party specifying table). This is a part of the repair estimate process. The *transmission unit* that is adapted to transmit certain information to the user via a network is the hardware and software of the system of Li that outputs data to the terminal of a user, such as the person requesting or viewing the estimate data that the system provides. The data is sent over a network as claimed. Not disclosed is that there is a *determination unit* that determines whether or not a *ratio of the repair fee estimate to the "specified price"* (the price for a new part) is a predetermined value or more. Wong discloses an auto repair estimating system that provides estimates for auto repairs. Wong discloses that the system has the ability to compare the cost for repairing a particular part to the cost of replacing the part to see which one is cheaper and is a better decision. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Li with a determination unit that determines whether or not the cost of a repair is greater than a predetermined fee, such as the cost of a replacement part, so that it can be seen which is cheaper. If it costs more to repair something than to simply replace the part, one would surely want to have the part replaced, because the cost is cheaper and you get a totally new part. The output of this analysis would be the cost to repair versus the cost to replace, which

satisfies the claimed limitation of the transmission unit being adapted to transmit information about a repair estimate and new products (the new part itself). This is also language directed to non-functional descriptive material as the data that is claimed is not part of the system and is describing what kind of data the system is able to transmit. With respect to the recitation that it is a ratio that is being compared, one of ordinary skill in the art would have recognized that one could do the comparison step of a repair to a replacement by either comparing the costs outright, or by using a ratio, where if the value of the ratio is less than 1, this indicates that the repair costs less than a replacement. This is just another mathematical way to compare the two numbers and is something that would have been obvious to one of ordinary skill in the art.

For claims 62,65,68, Li inherently has a table specifying parts as claimed, this was addressed with respect to claim 61. Not disclosed is that the estimation unit looks up a *delivery date specifying table*. This is interpreted to be the act of determining whether or not a particular part is in stock or not, which indicates the delivery date to the customer. If the part is in stock, then the repair could potentially be done the same day, whereas if the part needs to be ordered, it may take a day or more to obtain the necessary part, which would also depend on the part needed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the system of Li determine the "delivery date" of a part by determining if the part is in stock or not. This satisfies what is claimed.

7. Applicant's arguments filed 10/23/06 have been fully considered but they are not persuasive.

With respect to the arguments for patentability, the examiner disagrees with applicant and refers applicant to the rejection of record. Applicant has not addressed the references in any real amount of detail with respect to the combination of references as set forth by the examiner, so the argument is taken as more of a mere allegation of patentability than a traversal based on the merits. Applicant has not addressed the combination of references as set forth by the examiner in the current and most recent rejection of record. The arguments are non-persuasive.

8. This is a RCE of applicant's earlier Application No. 09/921,569. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DENNIS RUHL
PRIMARY EXAMINER